

## **REMARKS**

In the final Office Action mailed August 13, 2008, the Examiner rejected claims 1, 2, 4, 7, 8, and 11-24 under 35 U.S.C. §103(a) as being unpatentable over EP 1040910 to Best (with U.S. Patent 6,342,457 cited as the translation thereof) in view of Espe (U.S. Patent Application Publication No. 2001/0029139). The Examiner next rejected claims 1, 2, 4, 7, 8, and 11-24 under 35 U.S.C. §103(a) as being unpatentable over Best in view Espe and further in view of Hennecken (DE 19709644).

Applicant appreciates the Examiner's time and consideration in discussing this matter with Applicant's representative, Attorney Kirk Deheck (Reg. No. 55,782), during the telephone conference of October 22, 2008. Furthermore, Applicant appreciates the Examiner's insight regarding the distinctions between knitted pad construction and performance with respect to considerations related to woven pad construction and performance. Applicant further appreciates Mr. Choi's consideration inasmuch as the Examiner is the third different Examiner having been assigned to the above-captioned matter.

Although Applicant appreciates the Examiner's extensive articulation with respect to the references of record, Applicant hopes that the amendments presented herein will be well received. Arguably, the searches and consideration associated with the above-captioned matter should be generally extensive heretofore in view of the consideration of three separate Examiner's and at least two Supervisory Patent Examiners. The multiple Office personnel handling this matter aside, Applicant notes that the newly articulated rejections in the final Office Action of August 13, 2008 relate to references previously made of record and contradict the previous indication of allowability as discussed in the Response filed February 19, 2008. Further, even though the Examiner cites additional art in the Office Action mailed August 13, 2008, the relevance of which is discussed further below, at least one of the outstanding rejections is premised solely on art that has long been of record. Although Applicant appreciates the Office's right to perform updated searches and consider newly uncovered references as well as those previously of record, such action is beginning to unnecessarily forestall the further prosecution of this matter. Accordingly, should the Examiner consider the amendments presented herein insufficient to gain the allowance of the claims as presented herein, for purposes of appeal, Applicant requests timely issuance of an Advisory Action. Further, as Applicant has amended each of the independent claims to explicitly recite that which was inherent in the previous presentations of the claims, Applicant hopes that the consideration of the

claims as presented herein will be relatively straight forward. To further crystallize at least one basis by which Applicant believes the pending claims are in condition for allowance, Applicant offers the following remarks regarding the outstanding rejections.

Each of claims 1, 11, and 18 has been amended to further define that the present invention is directed to woven fabric - as inherently associated with usage of the terms "warp" and "weft" in describing the threads of the press pad fabric. Best is clearly directed to pressing cushions having knitted rather than woven fabric. Applicant does not necessarily disagree that Best discloses various cushion pads that can be constructed of various materials as disclosed at column 1, lines 23-42. However, Best further discloses that such structures suffer from drawbacks and that it is "the object of the invention to configure a pressing cushion in such a way that a wide range of possible variations for designing the pressing cushion exists" and that "this object is achieved in that the thread system has a knitted material or is made of a knitted material...." C. 1, ll. 47-58. That is, Best clearly teaches away from forming a pad from woven fibers as defined in the pending claims inasmuch as such prior art pads are asserted to suffer from drawbacks regarding elongation, compression, strength, and compressive elasticity.

In combining the disclosure of Espe with Best, the Examiner asserts that "When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another." The Examiner further maintains that, "if a person of ordinary skill in the art implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability." (Emphasis added). There is simply no disclosure, teaching, or suggestion in the art of record for forming a press pad of a woven fabric wherein one of the warp and weft is formed by an alternating series of threads that have a two part sheath and core construction, that have different elasticities, and the same outer diameter as defined by the pending claims. Simply, the Examiner's rejection is premised upon an obvious try rationale rather than the likelihood that a person of ordinary skill in the art would derive the claimed assembly from the isolated disclosures of Espe and Best as is required by the "would see the benefit of doing so" underlined above.

As stated in MPEP §2112, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (Emphasis in original) MPEP §2112 further states that "Inherency however, may not be established by probabilities or possibilities" and that "the mere fact that a certain thing may result from a given

set of circumstances is not sufficient.” Simply, the mere fact that the prior art discloses a number of alternate thread constructions is insufficient to support the allegation that one of ordinary skill in the art would yield the claimed invention from such disclosures. Espe and Best are devoid of any teaching or suggestion to combine the various threads disclosed therein in the manner recited in the pending claims. Applicant does not necessarily disagree that Espe discloses a two part thread and a number of variants thereof. However, there is no disclosure in Espe or Best for forming a pad wherein one of a warp or a weft is formed by a number of alternating threads having the claimed constructions that yield the claimed results.

Even assuming arguendo that Best and Espe can be combined, the reasonable combination of these references would simply replace one of the threads of Best with one of the threads of Espe. There is simply no suggestion in either of the references for providing one of a warp and weft with alternative threads of 1) different constructions, 2) different elasticities, and 3) similar diameters as called for in the pending claims. Furthermore, as Best clearly teaches away from woven pad constructions as compared to knitted pad structures, the combination of Best with Espe to provide a woven pad fabric, as defined by warp and weft threads and further defined by the amendment presented herewith and as defined by the claims, is simply untenable. One of ordinary skill in the art would readily appreciate the essential differences as regards manufacturing processes as well as properties of woven fabrics as compared to knitted fabrics. Simply, with respect to the knitted fabric as clearly shown in the drawings of Best, adjacent portions of each stitched thread 5 extends in crossing directions with respect to the axis of cushion threads 2. Accordingly, the elasticity of stitched threads clearly affects the lateral and longitudinal elasticity of the overall cushion. Even assuming Espe and Best are combinable, the reasonable combination of these references results in replacement of one of stitched threads 5 and cushion threads 2 and not the addition of an additional thread as is required by the present claims. Accordingly, for the reasons set forth above, Applicant believes that which is called for in the present claims is patentably distinct over the prior art.

With respect to the rejection of claims 18-20 and 24, the Examiner asserts that “the claimed properties appear to be inherent characteristics of the threads of the prior art since the prior art teaches substantially similar structures and compositions of the sheathes or cores as the claimed threads as evidenced by Applicants’ specification at pages 4 and 5.” Applicant does not disagree that the cited portion of the specification generally discloses that 1) there are a variety of thread

constructions disclosed in the prior art (such as Applicant's prior work discussed above as Espe) and that 2) there are drawbacks to the workability and performance of some of these structures. However, contrary to the Examiner's conclusion, there is no disclosure in the cited portions of Applicant's specification for the formation of a woven pad from alternating threads having the varied constructions as defined by the pending claims.

The Examiner maintains that "products of identical structure and composition cannot have mutually exclusive properties" and that "the burden is on the Applicant's to prove otherwise." Applicant finds no such requirement within the guidance of the MPEP. Simply, there is no disclosure or suggestion in the art of record for forming a press pad of a number of woven members wherein at least one of the warp and weft is formed by a number of alternating threads having different cross-sectional constructions, different elasticities, and similar outer diameters as defined in the present claims. Applicant does not disagree that the art of record (including this inventor's prior work) discloses a number of alternative thread constructions, however, such disclosure does not support the conclusions proffered by the Examiner.

The Examiner further rejected claims 1, 11, and 18 under 35 U.S.C. §103(a) as being unpatentable over Best in view of Espe and further in view of Hennecken. The disclosure of Hennecken adds nothing to overcome the shortcomings of Best and Espe as addressed above. Furthermore, as Hennecken states that "silicone-jacketed metal threads have proved to be particularly disadvantageous [because during modern manufacturing processes] the silicone surface also becoming [sic] detached from the inelastic metal wire...." Pg. 5, ¶ 1. As it relates to disclosing two part thread constructions, Hennecken discloses no more than Espe but for a non-translatable interface between the core and the sheath and a thread surface that contains a metal mixture. That is, Hennecken discloses a number of thread constructions that are useable with the present invention rather than providing an alternative pad construction as defined by the present claims. The threads of Espe and Hennecken provide variable threads for use in a pad. Neither of these references, alone or in combination with Best, discloses, teaches, or suggests a pad having the presently claimed construction. Accordingly, Applicant believes claims 1, 11, and 18, and the claims that depend therefrom, are patentably distinct over these references as well as the remaining art of record.

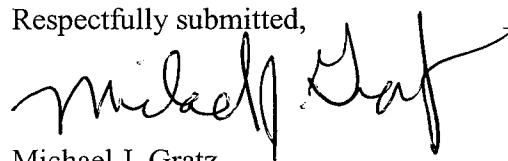
Therefore, Applicant respectfully requests a Notice of Allowance of claims 1, 2, 4, 7, 8, and 11-24. Furthermore, although no fees are believed due with this submission, the Office is hereby

Applicant: ESPE  
Serial No. 10/617,977  
Page 10 of 10

authorized to charge any applicable fees, or credit any overpayments, to Deposit Account No. 50-1170.

The Examiner is cordially invited to contact Applicant's representatives, Attorneys Kirk Deheck (Reg. No. 55,782) and/or Michael Gratz (Reg. No. 39,693), should any informal matters remain which would hinder or otherwise forestall passage of this matter to issuance. Furthermore, should the Examiner consider the claims as presented herein to be insufficient to gain allowance of this matter, Applicant requests timely issuance of an Advisory Action for consideration of further prosecution of this matter before the Board of Patent Appeals and Interferences.

Respectfully submitted,



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